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03/400,336	03/08/95	HOCKERSON	S A-59987-2/RE

C2M1/0426
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KAVANAUGH, EXAMINER	
ART UNIT	PAPER NUMBER
3208	

DATE MAILED:

04/26/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No. 08/400,336	Applicant(s) Hockerson
Examiner Ted Kavanaugh	Group Art Unit 3208



Responsive to communication(s) filed on Mar 18, 1996

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-4 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-4 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 1-4 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "sufficient", in line 3 of claim 3, is vague and indefinite as it is not clear as to the metes and bounds of such an expression.

In claim 1, line 2, the term "mounted" has been misspelled.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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3. Claims 1-4 are rejected under 35 U.S.C. § 103 as being unpatentable over US 4439936 (Clarke et al) in view of US 4939851 (Miller).

Clarke discloses an athletic shoe comprising a sole (multilayer sole 14) mounted to the upper, said sole bounded by a peripheral rim (the rim formed on the outer peripheral edges of the sole 14), a rigid heel counter (see the heel counter in figure 1 which are conventionally rigid), said sole being formed with a longitudinal channel (136,336,436) in the bottom surface with the channel extending through the peripheral rim and with the channel dividing the heel portion into a pair of laterally adjacent compression elements spaced an effective distance apart substantially as claimed except for a lasting board. Miller teaches a lasting board (22) mounted within the upper and above the sole of the shoe. It would have been obvious to provide the shoe of Clarke with a lasting board, as taught by Miller, to facilitate lasting the shoe during construction.

With regard to claim 3, the height between the channel and the upper (the connecting portion) appears to be sufficiently small to present minimal transfer of motion between the compression elements responsive to stress force.

The athletic shoe as taught above has all of the same structural elements and therefore it would clearly seem to be inherently capable of performing the function as claimed.

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Response to Amendment

4. Applicant's arguments with respect to claims 1-4 have been considered but are deemed to be moot in view of the new grounds of rejection.

Conclusion

5. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1148.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148. Facsimile correspondence for this application should be sent to (703) 305-3579.

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TED KAVANAUGH
PATENT EXAMINER
ART UNIT 3208

TK

April 16, 1996